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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,086	06/01/2005	Avraham Baniel	5114-00003	8098

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EXAMINER	
DEES, NIKKI H	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
07/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,086	BANIEL, AVRAHAM	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01 June 2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 13-18 and 20 are objected to because of the following informalities:

Claims 13-18 depend on claim 1, which has been cancelled;

Claim 20 depends on claim 8, which has been cancelled;

Claim 20, change "lest" to "least".

Appropriate correction is required.

2. For purposes of examination, claims 13-18 will be interpreted as being dependent upon claim 12. Claim 20 will be interpreted as being dependent upon claim 19.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 19 and 22 provide for the use of a glyceride ester, but, since the claims do not set forth any steps involved in the method/process, it is unclear what

method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 and 22 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12, 13, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhrt et al. (3,068,103).

9. The '103 patent teaches a process for preparing a diglyceride wherein glycerol is esterified first with a hydrogenated fat or oil such as peanut, cottonseed or olive oil. This resultant monoglyceride is then esterified with lactic acid to form a diglyceride. (col. 1 lines 43-72). The resultant diglyceride is used in the preparation of baked goods (col. 1 lines 25-30).

10. The '103 patent does not teach the resultant diglyceride as an acidulent. However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. *In re May*, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). See MPEP § 2112.02. As the compound taught by the prior art for inclusion in foodstuffs is the same as the compound claimed by Applicants for imparting acidity to foodstuffs, Applicant's claims 12, 13, 16, 19 and 20 are considered anticipated by the teachings of the prior art.

11. Claims 12, 13, 15-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hameyer et al. (4,209,451).

12. The '451 patent teaches a method for esterifying fruit acids with lactic acid and a partial glyceride of a fatty acid (Abstract). Fruit acids include tartaric, citric and malic (col. 2 lines 35-53). Partial glycerides of higher fatty acids, including combinations of stearic acid and palmitic acid may be used in the invention (col. 3 lines 34-36). A

combination of glycerol mono- and distearate (mono- and diglyceride), as well as monostearate, are esterified in the invention (col. 5 Examples 7-9).

13. The '451 patent does not teach the resultant glycerides as acidulents. However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. *In re May*, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). See MPEP § 2112.02. As the compound taught by the prior art for inclusion in foodstuffs is the same as the compound claimed by Applicants for imparting acidity to foodstuffs, Applicant's claims 12, 13, 15-17, 19 and 20 are considered anticipated by the teachings of the prior art.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hameyer et al. (4,209,451).

16. The '451 patent teaches a method wherein a mixture of mono- and diglycerides is further esterified with food acids (col. 3 lines 26-36).

17. The '451 patent is silent as to the glyceride being a diglyceride.

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected a diglyceride for further esterification with a food-grade acid as taught by the '451 patent. The '451 patent states that the fatty acids selected for use in the invention may vary based on the final use of the product, for example, whether or not they are to be milled or to be hydrophilic (col. 3 lines 26-36). One of ordinary skill would have been able to select a diglyceride for use in the invention of the '451 patent that was appropriate to the end use of the product. This would not have required undue experimentation on the part of the artisan, and there would have been a reasonable expectation that the esterification with the acidulant acid would have provided a triglyceride having two radicals derived from fatty acids and one derived from the acidulent.

19. Claims 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hameyer et al. (4,209,451) in view of Matsuo et al. (4,416,991).

20. The '451 patent teaches a method for esterifying fatty acids as detailed above.

21. The '451 patent is silent as to the use of enzyme mediated esterification and transesterification.

22. The '991 patent teaches a method for enzyme mediated transesterification of fatty acid esters (Abstract).

23. Because both the '451 patent and the '991 patent teach a method for esterification/transesterification of fatty acids, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted one

method for the other in order to achieve the predictable result of the esterification/transesterification of the fatty acids. This would not have required undue experimentation on the part of the artisan, and there would have been a reasonable expectation that the resultant product, whether produced by the enzyme mediated process or traditional esterification, would have functioned the same.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Radlove et al. (2,957,932) teach diglycerides produced from fatty acids and carboxylic acids including lactic acid for use in food products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees
Examiner
Art Unit 1794

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794